

Serial No. 10/766,829

IN THE DRAWINGS:

Please amend Figure 1 as illustrated in red on the attached photocopy.

REMARKS

Claim Rejections

Claim 3 is rejected under 35 U.S.C. §102(b) as being anticipated by Asakura (U.S. 5,995,372). Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Asakura in view of Anderson (U.S. 4,565,922).

Drawings

Applicant proposes to amend Figure 1, as illustrated in red on the attached photocopies. In Figure 1 it is proposed to add the label --Prior Art--. No "new matter" has been added to the original disclosure by the proposed amendments to this figure. It is believed the foregoing proposed amendments obviate the outstanding objections to the drawings. Approval of the proposed drawing changes is respectfully requested.

Claim Amendments

By this Amendment, Applicant has canceled claim 4 and has amended claim 3 of this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Traditional memory cards consist of a case and a circuit board. The traditional case has a thickness that cannot be shortened (normalized). The cost of materials cannot be decreased either. Another serious defect is that due to the limited space of case, the circuit board has to be made of special electronic parts, especially an IC with a smaller volume and a lower height. Following a trend toward light, thin, short, and small digital equipment, circuit parts and storage devices are gradually moving toward miniaturization. Therefore, the requirement of a manufacturing process, device, and technology is also getting more stringent, which is increasing the cost. In order to provide a larger space in the existing circuit layout and memory card with an original size, so as to be applied to an IC element with

ordinary specification or even larger size, and to design a more miniaturized memory card, the present invention is provided with the following characteristics:

1. Special IC elements with a smaller volume and a lower height are not required, as the space is increased. Therefore, the cost of manufacturing is decreased.
2. The entire space to be occupied is decreased, which enables a miniaturized design for the electronic products.

The present invention uses a circuit board configured with a contact terminal, capacitors, resistors, and a memory module as a substrate, to save the thickness of lower case, and directly puts a case on a top of the circuit board, such that a larger space can be formed between the circuit board and case for assembling more electronic parts with larger volume and cheaper price without changing the original fixed height. In addition, the effect of miniaturizing memory card can also be achieved.

Moreover, a substrate of traditional circuit board of memory card is not be used originally, i.e., there are no electronic parts installed on the substrate of circuit board. Therefore, by using the circuit board to replace the traditional lower case, the working area of circuit board will not be decreased, and the lower case can be saved, which provides the circuit board with another function.

The primary reference to Asakura teaches a card-type electronic device having a metal plate (3), a printed circuit board (2), printed patterns (4a) located on the printed circuit board, and a frame (1).

Asakura does not teach an end of the case being spaced apart from the first end of the circuit board a distance greater than a length of the first contact terminal; nor does Asakura teach a second contact terminal located on a bottom of the first end of the circuit board.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Asakura do not disclose each and every feature of Applicant's new claims and,

therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Asakura cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The secondary reference to Anderson teaches a key card apparatus having a card (1) having a first surface (2) having parallel contacts (20) and a second surface (4) having parallel contacts (40)

Anderson does not teach a case located above and spaced apart from the top of the circuit board; nor does Anderson teach an end of the case being spaced apart from the first end of the circuit board a distance greater than a length of the first contact terminal.

Even if the teachings of Asakura and Anderson were combined, as suggested by the Examiner, the resultant combination does not suggest: an end of the case being spaced apart from the first end of the circuit board a distance greater than a length of the first contact terminal.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Asakura or Anderson that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Asakura nor Anderson disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claim 4, thereby rendering moot the outstanding rejections under 35 U.S.C. § 103.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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